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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Richard FERNANDES

Serial No. 09/514,946

Filed: February 28, 2000

For: COMPUTER-IMPLEMENTED
APPARATUS AND METHOD
FOR GENERATING A
TAILORED PROMOTION

) **BEFORE THE BOARD OF PATENT**
) **APPEALS AND INTERFERENCES**

)
) Appeal No.:

)
) Examiner: Jeffrey D. Carlson

)
) Group Art Unit: 3622

)
) July 6, 2004
) (Tuesday After Holiday)

)

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is a reply to the Examiner's Answer dated May 6, 2004, pursuant to 37 CFR § 1.193(b). Initially, it is noted that, contrary to the Answer's assertion at page 2, Appellant's main brief does in fact contain a statement regarding related appeals and interferences. See Brief at 2.

ISSUES

This appeal presents the following issues for decision by the Board:

noted
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- 1) Whether claims 1, 3-10 and 22-25 are obvious over Gardenswartz et al, U.S. Patent No. 6,055,573 ("Gardenswartz") in view of Roth et al. , U.S. Patent No. 6,285,987 ("Roth") under 35 U.S.C. § 103 and are properly rejected on that basis; and
- 2) Whether claim 8 is alternatively obvious over Gardenswartz in view of Travis et al., U.S. Patent Application Publication No. 2002/0010668 ("Travis").

REPLY TO EXAMINER'S ANSWER

The Rejection of Claims 1, 3-10 and 22-25 Under 35 U.S.C. § 103 Is Improper

The rejection of claims 1, 3-10 and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over Gardenswartz in view of Roth is improper and should be reversed. First, the Answer fails to establish a *prima facie* case of unpatentability.

The Answer has not shown where each and every limitation of the claims on appeal is achieved by the proposed combination of prior art references. The Answer asserts only that Gardenswartz discloses "provid[ing] targeted banner ads to Internet web site visitors," "discloses Internet-connected users that collect cookies stored on their machines as they visit different web sites," (Answer at 3) and that Gardenswartz "suggests relying on Internet activity *including online purchases* as a basis for targeted advertising" (Answer at 4, emphasis in original). The Answer then alleges that Roth "teaches a central server that is used to carry out targeted Internet advertising at various websites," and "teaches tracking user's visits to particular web sites [col 1 lines 30-38] and using this information to provide

targeted ads" (Answer at 4). The Answer then concludes that "it would have been obvious to one of ordinary skill at the time of the invention to have implemented a centralized system as described by Roth et al so that targeted ads can be selectively sent to web site viewers of various/plural subscribing member web sites" (Answer at 5).

The Answer fails to establish a *prima facie* case of obviousness, because the Answer fails to provide any explanation of how Roth is to be combined with Gardenswartz, where Gardenswartz would be modified according to Roth, and what would be the modification to what system of Gardenswartz. The Answer further fails to correlate the limitations of the claims with the proposed combination of prior art references. The Board is left to speculate as to what the structure of the resultant system would be, and what functions the resultant system would perform, according to the combination proposed in the rejection.

The Answer further fails to explain why one of ordinary skill in the art would have been motivated to modify Gardenswartz in view of Roth as proposed. According to the rejection, Gardenswartz "discloses" using cookies to customize a web page served to a client, and "suggests" using "*online purchases* as a basis for targeted advertising." It is thus not apparent what shortcoming of Gardenswartz as interpreted by the Examiner would be remedied by Roth. The Answer alleges that implementation of a Roth system would provide "targeted ads [that] can be selectively sent to web site viewers of various/plural subscribing member web sites." However, according to the Examiner, "the participating web site that displays the targeted advertising is taken to be a subscriber/subscriber site." Answer at 7. If

Gardenswartz “teaches” using cookies that store a user’s online activity to generate targeted ads for display in the user’s browser as alleged by the Examiner, then Gardenswartz would appear to have already the ability to send a targeted ad to a viewer of a subscriber web site. From the above, it is apparent that the proposed combination of prior art is based not on a cohesive reason apparent to one skilled in the art, but instead is based on a hindsight effort to somehow reconstruct the claimed invention.

Second, the Answer argues that the background disclosure of the Gardenswartz patent is properly relied on “for what it teaches, which is equally available to one of ordinary skill as is the summary and detailed disclosure of Gardenswartz et al.” This argument establishes that the Examiner has misapprehended the controlling law on the proper determination of obviousness under 35 U.S.C. § 103.

As explained in the main brief, a prior art reference must be considered as a whole. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). In contrast, the Answer itself has established that the Examiner has considered Gardenswartz not as a whole for what it fairly suggests to one of ordinary skill in the art, but instead has selectively chosen isolated bits and pieces of the reference as needed to reconstruct the claimed invention. The Answer admits that the Examiner has separately considered the background section of Gardenswartz “for what it teaches,” independently of the summary and detailed disclosure of the Gardenswartz patent itself. See Answer at 7. Such use of the prior art is clearly improper according to the established law of obviousness,

under which the entire disclosure of the prior art must be evaluated as a whole for what it suggests, and what it discourages to those of ordinary skill in the art. In re Haruna, 249 F.3d 1327, 58 USPQ2d 1517 (Fed. Cir. 2001).

As previously demonstrated, while Gardenswartz mentions use of online activity in the Background of the Invention, Gardenswartz teaches that use of such activity is disadvantageous. See col. 2, ll. 43-48. Thus, those skilled in the art presented with the Gardenswartz reference would be led away from using such online activity. It is thus incorrect to state that Gardenswartz “teaches” in the Background of the Invention the use of online activity to develop targeted ads, when the rejection is based on a combination or modification of Gardenswartz with additional prior art, which requires a teaching, motivation or suggestion from the prior art taken as a whole.

Third, the Answer still has failed to come to terms with the concept of a subscriber to a tailored promotion-generating apparatus as disclosed and claimed in the present application. The final rejection construed the term “subscriber” as meaning one who expresses concurrence or assent, as to a belief or notion. The Answer apparently has abandoned this admittedly non-sensical construction and now interprets a “subscriber” as simply being the web site that displays the advertisement. In doing so, the Answer runs into the problem that the claims define a subscriber as an online merchant offering goods and/or services that are the subject of the tailored promotion. The Answer unsuccessfully attempts to reconcile this dilemma by interpreting an “offer” as being the same as the display of the

ad. See Answer at 5. Of course, if the web site that displays an ad is a "subscriber" and goods offered by a subscriber are simply the ad itself, then the claim language would be indefinite under 35 U.S.C. § 112 second paragraph as being redundant. When the claim language is properly construed in light of the specification as it would be by one skilled in the art (and not by one attempting to reconstruct the claimed invention from the prior art), there can be no dispute that neither Gardenswartz nor Roth nor any possible combination of the two could result in the claimed invention.

**The Rejection of Claims 3, 4, 10 and 24 Under 35 U.S.C. § 103
Is Improper**

Claim 3 requires a database of subscribers to the tailored promotion. Neither Gardenswartz nor Roth disclose such a database, and the final rejection has failed to even address this limitation. Consequently, the rejection of claim 3 is improper and should be reversed.

Claim 4 requires that a particular network site is a subscriber listed in the database of subscribers to the tailored promotion. Neither Gardenswartz nor Roth disclose such a feature, and the final rejection has failed to even address this limitation. Consequently, the rejection of claim 4 is improper and should be reversed.

Claim 10 requires that the apparatus receive activity information from a consumer's computer upon a visit by the consumer to a first network site. Neither Gardenswartz nor

Roth disclose such a feature, and the final rejection has failed to even address this limitation. Consequently, the rejection of claim 10 is improper and should be reversed.

Claim 24 requires that the plurality of network sites providing consumer activity information include non-subscriber network sites. Neither Gardenswartz nor Roth disclose such a feature, and the final rejection has failed to even address this limitation.

Consequently, the rejection of claim 24 is improper and should be reversed. The Answer fails to address any of the limitations set forth above; instead, the Answer merely repeats the inapposite and unsupported conclusions of the final rejection.

The Rejection of Claim 8 Under 35 U.S.C. § 103
Is Improper

The Answer expresses confusion as to Appellant's separate arguments regarding the separate grounds of rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Gardenswartz in view of Roth, and Gardenswartz in view of Travis (Answer at 8). The Examiner is invited to review the requirements of 37 CFR § 1.192(c)(8)(iv).

The Answer characterizes Travis as "teach[ing] targeting ads to web site visitors by using purchases made and products reviewed – highly 'relevant' to applicant's field of endeavor and to Gardenswartz et al." Answer at 8-9. Again, the Answer's generalized overview of Travis does not correspond to the standard of consideration of the prior art as a whole for what it teaches to those of skill in art, that is required by the binding legal

precedent. The Answer improperly construes the disclosure of the prior art in its broadest possible sense, so as to analogize the prior art with the limitations in the claims. It is well established that an analysis of the prior art must focus on what the prior art teaches to those skilled in the art, and not on the breadth of terminology used in the reference, in determining whether a prior art reference discloses a claimed invention. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

CONCLUSION

In view of the foregoing and the arguments in the main brief filed February 17, 2004, claims 1, 3-10 and 22-25 are submitted to be directed to a new and unobvious method and system for offering promotional awards to visitors of electronic commerce sites, which is not taught or suggested by the prior art. The Honorable Board is respectfully requested to reverse all grounds of rejection and to direct the passage of this application to issue.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,
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